

REMARKS

Applicant appreciates the Examiner's allowance of Claims 39, 41, 43, 44, 46, 48, 49, 51, 53 and 57-59. Applicant is amending Claims 24, 29, 34, 39, 44 and 49 herein to correct punctuation errors therein. These amendments are not in response to a patentability rejection, add no new matter, and do not change the scope of the claims.

Applicant will now address the Examiner's remaining rejections in the Office Action.

Claim Rejections - 35 USC §103

In the Office Action, the Examiner rejects Claims 24, 25, 28 and 54 under 35 USC §103(a) as being unpatentable over Zaleski (US 5,455,791) together with Yamazaki et al. '702 (US 6,127,702) and rejects Claims 29, 30, 33, 34, 35, 38, 55 and 56 under 35 USC §103(a) as being unpatentable over Zaleski together with Yamazaki '702 and Liu (US 5,814,854). These rejections are respectfully traversed.

Applicant respectfully submits that these rejections are improper under 35 USC §103(c).

In particular, 103(c)(1) states:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (f) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

In this case, the present application was filed on October 27, 2003 as a divisional application under 35 USC §120 of U.S. application serial no. 09/192,745 filed on November 16, 1998. While Yamazaki '702 was filed on September 16, 1997, it did not issue as a patent until October 3, 2000. Hence, the Examiner must be citing Yamazaki '702 as a §102(e) reference. Further, both the present application and Yamazaki '702 are owned by the same person or

subject to an obligation of assignment to the same person (i.e. Semiconductor Energy Laboratory Co., Ltd.).

Therefore, since Yamazaki '702 is viewed as subject matter developed by another person (Yamazaki et al.; the present application is to Yamazaki) which qualifies as prior art only under §102(e) and the subject matter of Yamazaki '702 and the claimed invention are owned by the same person or subject to an obligation of assignment to the same person, Yamazaki '702 shall not preclude patentability under §103.

Accordingly, it is respectfully requested that these rejections be withdrawn.

JP-10-093100

JP-10-093100 is a Japanese publication of the priority application for Yamazaki '702. JP '100 was published on April 10, 1998. Applicant notes that this reference was cited in the present application in an IDS filed on December 31, 2003. The Examiner reviewed this reference and initialed the 1449 form indicating his review of the reference in the Office Action of January 7, 2005 (the reference was not the subject of a rejection).

In light of the above, Applicant wishes to make of record that JP '100 is not prior art to the present application.

JP '100 was published on April 10, 1998.

The present application was filed on October 27, 2003 as a divisional application under 35 USC §120 of U.S. application serial no. 09/192,745 filed on November 16, 1998 which claims the benefit under 35 USC §119 of the following foreign applications:

serial no. JP-09-333453 filed on November 18, 1997 in Japan,

serial no. JP-09-337710 filed on November 21, 1997 in Japan, and

serial no. JP-09-340754 filed on November 26, 1997 in Japan.¹

Each of these priority applications was filed prior to the publication date of JP '100. Hence, JP '100 is not prior art to the present application.

New Claims

Applicant is also adding new Claims 60-83. It is respectfully requested that these new claims be entered and examined at this time.

If any fee should be due for these new claims, please charge our deposit account 50/1039.

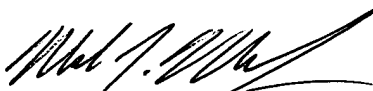
Conclusion

It is respectfully submitted that the present application is in a condition for allowance and should be allowed.

If any further fee is due for this amendment, please charge our deposit account 50/1039.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,



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¹ Applicant is preparing an English translation of the priority document and will submit it as soon as it is finished. A certified copy of these applications was filed in the parent application 09/192,745.